



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,557	06/12/2002	Olga Bandman	PF-0693 USN	5013

27904 7590 04/21/2004

INCYTE CORPORATION
3160 PORTER DRIVE
PALO ALTO, CA 94304

EXAMINER

MERTZ, PREMA MARIA

ART UNIT	PAPER NUMBER
----------	--------------

1646

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
10/009,557

Applicant(s)
Bandman et al.

Examiner
Pema Mertz

Art Unit
1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 17, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-23 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit: 1646

DETAILED ACTION

Election/Restriction

1. This application is a 371 of PCT/US00/12811. For applications filed under 371, PCT rules for lack of unity apply.

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains inventions or groups of inventions which are not so linked as to form a single inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Groups 1-25. Claims 1-2, 15 are drawn to a polypeptide of amino acid sequence set forth in SEQ ID NO:1-25.

Groups 26-50. Claims 3-6, 8, 10-11 are drawn to a nucleic acid encoding a protein of amino acid sequence set forth in SEQ ID NO:1-25, a vector, a host cell and a process for producing the receptor polypeptide.

Groups 51-75. Claim 7 is drawn to a transgenic organism comprising a nucleic acid encoding a protein of amino acid sequence set forth in SEQ ID NO:1-25, classified in Class 800, subclass 21.

Groups 76-100. Claim 9 is drawn to an antibody to a polypeptide of amino acid sequence set forth in SEQ ID NO:1-25, classified in Class 530, subclass 387.9.

Art Unit: 1646

Groups 101-125. Claims 12-14 are drawn to a method of detecting a target polynucleotide in a sample using the nucleic acid encoding the polypeptide of amino acid sequence set forth in SEQ ID NO:1-25, classified in Class 435, subclass 6.

Group 126-150. Claim 16 is drawn to a method of treatment by administering the polypeptide of amino acid sequence set forth in SEQ ID NO:1-25, classified in Class 514, subclass 2.

Group 151-175. Claims 17, 20, 23, are drawn to a method for screening for an agonist or an antagonist of the polypeptide of amino acid sequence set forth in SEQ ID NO:1-25 or for a compound that alters expression of the polynucleotide encoding the polypeptide of amino acid sequence set forth in SEQ ID NO:1-25, classified in Class 435, subclass 7.1.

Group 176-200. Claims 18, 21, is drawn to an agonist or an antagonist of the polypeptide of amino acid sequence set forth in SEQ ID NO:1-25, class and subclass undeterminable.

Group 201-225. Claims 19, 22 are drawn to a method of treatment with the agonist or the antagonist of the polypeptide of amino acid sequence set forth in SEQ ID NO:1-25, class and subclass undeterminable.

Should any one of the Groups from 1-225 be elected, Applicant is required to select one polypeptide (one amino acid sequence) as set forth in Table I. Once one polypeptide sequence is selected, all other sequences will be withdrawn from consideration.

The inventions listed as Groups 1-225 do not relate to a single general inventive concept under PCT Rule 13.1 because under PCT Rule 13.2 they lack the same or corresponding special technical feature for the following reasons:

Art Unit: 1646

The PCT rules define a special technical feature as a feature which defines a contribution over the prior art. The first claimed invention fails to recite such a feature, since any fragment of an isolated protein comprising an amino acid fragment of the polypeptide sequence set forth in SEQ ID NO:1 meets the limitations of the first invention. Furthermore, a biologically active fragment encompasses a single amino acid and any single amino acid of the 35 or 40 kD proteins disclosed in WO 92/05256 meets the limitations of the first claimed invention. Since the first claimed invention lacks a special technical feature, the other claimed inventions cannot share a special technical feature with the first claimed invention.

Inventions 1-25, 26-50, 51-75, 76-100, 176-200, are independent and distinct, each from the other, because they are products which possess characteristic differences in structure and function and each has an independent utility, that is distinct for each invention which cannot be exchanged. The polynucleotides of inventions 26-50 can be used to make hybridization probes or can be used in gene therapy as well as in the production of the specific proteins of interest. The proteins of inventions 1-25 can be used as probes, or used therapeutically or diagnostically, e.g. in screening. The antibodies of inventions 76-100 can be used to obtain the polynucleotides of Groups 26-50, and can also be used in diagnostics, e.g. as a probe in immunoassays. Each of the polynucleotides of inventions 26-50 can be used to produce the specific polypeptides of Groups 1-25, respectively. The polynucleotide of Group 26 can only be used to produce the protein of Group 1 but not the proteins of Groups 2-25. The transgenic animals of inventions 51-75 can be used in screening, to study the effect of drugs or the over expression of the proteins of inventions 1-25, respectively.

Art Unit: 1646

The inventions of Groups 176-200 are distinct from the products of Groups 1-25 because the polypeptide products can be made by a materially different method, such as recombinant protein expression. The inventions of groups 1-100 are distinct from the products of Groups 176-200 because the products of Groups 1-100 can be used in methods that are materially different from the therapy of Groups 201-225. The methods of Groups 101-175 and 201-225 are independent and distinct, each from the other, because the methods are practiced with materially different process steps for materially different purposes and each method requires a non-coextensive search because of different starting materials, process steps and goals.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Advisory Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prema Mertz whose telephone number is (703) 308-4229. The examiner can normally be reached on Monday-Friday from 7:00AM to 3:30PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564.

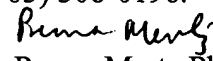
Art Unit: 1646

Official papers filed by fax should be directed to (703) 305-3014 or (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 746-5300.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [yvonne.eyler@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.


Prema Mertz Ph.D.
Primary Examiner
Art Unit 1646
June 17, 2003